



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/954,245	10/20/97	LEBOURGEOIS	J CYP1010WSW

LM01/0127  
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EXAMINER	
SOLOMON, K	
ART UNIT	PAPER NUMBER
2767	3

DATE MAILED: 01/27/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/954,245

Applicant(s)

John H. LeBourgeois

Examiner

Keisha Solomon

Group Art Unit

2767

☒ Responsive to communication(s) filed on Oct 20, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 16, 17, and 26-28 is/are allowed.

☒ Claim(s) 1-9, 18-21, and 29-31 is/are rejected.

☒ Claim(s) 10-15, 22-25, and 32-38 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. Claims 1-38 have been examined.

#### *Drawings*

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### *Specification*

3. The following title is suggested: **DIGITALLY CERTIFYING A USER IDENTITY AND A COMPUTER SYSTEM IN COMBINATION.**
4. The disclosure is objected to because of the following informalities:
  - a. Page 25, line 19; page 25, line 20; page 28, line 5; page 34, line 24; page 35, line 7: "step 414", "step 416", "step 514", "step 1014", and "step 1020", respectively should be enclosed in "()" to maintain consistency with the specification by indicating that they are decisional steps.
  - b. Page 28, line 2: "(step 512)." should be inserted after "I.D."
  - c. Page 35, line 5: "in" should be replaced after "104" and "()" be removed from "(step 1016)." Step 1016 is not one of decision. Appropriate correction is required.

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***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1-6, 18-21, and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ensor et al., U.S. Patent No. 5,721,780.

As per claims 1 and 29 , Ensor et al. teach storing at a first time, a first signature dependent upon a first user identity and a first user system in combination; generating, at a second time subsequent to first time, a second signature dependent upon a second user identity and a second user system in combination; and certifying, in dependence upon first and second user signatures, whether the combination of second user identity and second user system match the combination of first user identity and said first user system (abstract and column 2, lines 31-51).

As per claim 2, Ensor et al. teach the step of storing comprising the step of developing first signature in dependence upon a first user identity code and in dependence further upon a first group of at least one component as present in first user system at first time (abstract and column 2, lines 18-37).

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As per claim 3, Ensor et al. teach a method of developing a first signature comprising the step of obtaining a first user identity code in response to user input (abstract; FIG.3; and column 2, lines 31-37).

As per claim 4, Ensor et al. teach a method of storing further comprising the step of storing first signature accessibly to a certification server, and wherein step of certifying comprises the step of certification server developing a certification result in dependence upon first and second signatures (abstract and column 2, lines 31-51).

As per claims 5, 21, and 30, Ensor et al. teach a method wherein second user system is first user system (abstract and column 2, lines 31-51). When comparison of the two passwords result in a match, it is conclusive that the same user terminal, (i.e. same telephone number/identity code) is requesting access.

As per claims 6 and 31, Ensor et al. teach a method wherein step of certifying comprises the step of certifying, in dependence upon first and second signatures, whether the combination of second user identity and second user system match the combination of first user identity and first user system, and further that second signatures was generated at a time different from said first time (column 2, lines 38-51), subsequent time is at a time different.

As per claim 18, Ensor et al. disclose a certification method comprising the steps of: forming, at a first time, a first signature dependent upon a first user identity and a first user system in combination (abstract and column 2, lines 38-51); providing the first signature to a certification server (abstract and column 2, lines 38-51); generating, in response to an inquiry

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from an inquiring system at a second time subsequent to the first, a second signature dependent upon a second user identity and a second user system in combination (abstract and column 2, lines 38-51); and providing second signature for comparison with said first signature (abstract and column 2, lines 38-51).

Ensor et al. do not explicitly disclose the use of signatures or user identities. However, these features are deemed inherent to the Ensor et al. method and apparatus as the abstract and lines 38-51 of column 2 show that passwords (signatures) are generated when a connection to the telephone network is made by the user terminal (telephone line). The telephone number of the user terminal is the user identity in this disclosure.

As per claim 19, Ensor et al. disclose a method of forming a first signature comprising the step of developing first signature in dependence upon a first user identity code and in dependence further upon a first group of at least one component as present in first user system at first time (abstract; FIGS 2 & 3; and column 2, lines 18-37). It is deemed inherent that a telephone network is a group of at least one or more user terminals (components), where each terminal has a unique telephone number (identity code).

As per claim 20, Ensor et al. teach a method of developing a first signature comprising the step of obtaining a first user identity code in response to user input (abstract; FIG. 3; and column 2, lines 31-37).

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***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ensor et al., U.S. Patent No. 5,721,780 as applied to claims 1 and 6 above, and further in view of Davis, U.S. Patent No. 5,796,840.

As per claim 7, Ensor et al. teach all of the limitations except a step wherein generating a second signature is performed in response to a challenge, wherein second signature is further dependent upon a challenge, and wherein the step of certifying comprises the step of developing a certification result in dependence upon first and second signatures and further in dependence upon challenge. This step is taught by Davis (figure 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a second signature in response to a challenge and develop certification results in dependence upon the challenge and signatures.

As per claim 8, Ensor et al. fail to teach a step of providing a challenge code, wherein a second signature is further dependent upon challenge code. Davis discloses a method of a second signature is dependent upon a challenge code (figure 8). It would have been obvious to

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one of ordinary skill in the art at the time of the invention to generate a second signature dependent upon a challenge code.

As per claim 9, Ensor et al. fail to teach a step of certifying comprising the step of developing a certification result in dependence upon first and second signatures and further in dependence upon challenge code. However, Davis teaches the development of a certification result in dependence upon first and second signatures and further in dependence upon challenge code (figure 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to develop certification results in dependence upon first and second signatures and further in dependence upon challenge code.

***Allowable Subject Matter***

9. Claims 10-15, 22-25, and 32-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 16-17 and 26-28 are allowed.

11. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities

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remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

*Conclusion*

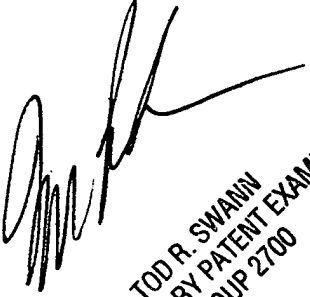
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keisha Solomon whose telephone number is (703) 305-1373. The examiner can normally be reached Monday-Thursday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached at (703) 308-7791.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-5357. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

KYS

January 19, 1999



TOD R. SWANN  
SUPERVISORY PATENT EXAMINER  
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